

REMARKS

Interview request

Applicants respectfully request a telephonic interview after the Examiner has reviewed the instant response and amendment. Applicants request the Examiner call Applicants' representative at (858) 720-5133.

Status of the Claims*Pending claims*

Claims 1 to 7, 9 to 12, 16, 17, 28 to 44, 46 to 49, 51 to 53 and 55 are pending and under consideration. Claims 34, 35, 38 and 44 have been withdrawn. Thus, claims 1 to 7, 9 to 12, 16, 17, 28 to 33, 36, 37, 39 to 43, 46 to 49, 51 to 53 and 55 are pending and under consideration.

Allowed claim

Applicants thank the Examiner for finding claim 16 allowable.

Outstanding Rejections

The rejection of claims 1, 2, 4 to 7, 9 to 12, 28 to 33, 36, 37, 39 to 43, 46 to 49, 51 to 53 and 55, under 35 U.S.C. §112, first paragraph, is maintained (enablement requirement). Claim 5 is rejected under 35 U.S.C. §112, second paragraph.

Applicants respectfully traverse all outstanding objections to the specification and rejection of the claims.

Support for the Claim Amendments

The specification sets forth an extensive description of the invention in the amended claims in this and previous responses. For example, support for synthetic nucleic acids of the invention can be found, inter alia, in paragraphs [0038], [0040], [0044], [0059], and [0113], of U.S. Patent publication no. 20020132997. Accordingly, Applicants submit that no new matter has been introduced and the instant amendment can be properly entered.

Claim Objections

The Office had concerns regarding the temperature range of the hybridization conditions limitation in claim 5 (see page 3, lines 1 to 6, of the OA). The instant amendment addresses this issue.

Issues under 35 U.S.C. §112, second paragraph

Claim 28 is rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for use of the phrase “a polymerase activity”, for reasons set forth in detail on page 3, of the OA. The instant amendment addresses this issue.

Issues under 35 U.S.C. §112, first paragraph

The rejection of claims 1, 2, 4 to 7, 9 to 12, 28 to 33, 36, 37, 39 to 43, 46 to 49, 51 to 53 and 55, under 35 U.S.C. §112, first paragraph, is maintained because the specification allegedly does not reasonably provide enablement for the claimed invention (enablement requirement), for reasons set forth in detail on pages 4 to 6, of the OA.

The Office states that the specification is enabling for the polynucleotide of SEQ ID NO:1, which encodes a polypeptide having polymerase activity.

However, it is alleged, inter alia, that the specification does not provide reasonable enablement for any nucleic acid of 100 consecutive bases of SEQ ID NO:1, and encoding a polypeptide having polymerase activity.

Applicants respectfully traverse, and request consideration of these remarks and reconsideration of Applicants' responses of May 15, 2006; March 28, 2005; September 17, 2004; and August 25, 2004. However, merely to expedite prosecution and allowance of the pending claims, the instant amendment also addresses this issue.

Applicants also note that while only claim 12 encompasses use of the limitation “at least 100 consecutive bases of the sequence as set forth in SEQ ID NO:1,” and this rejection appeared to focus on the Office's concerns with use of this phrase, all of claims 1, 2, 4 to 7, 9 to 12, 28 to 33, 36, 37, 39 to 43, 46 to 49, 51 to 53 and 55 were rejected.

Nevertheless, after entry of the instant amendment, claim 12 will be directed to, inter alia, isolated, synthetic or recombinant nucleic acids comprising sequences that encode enzymatically active fragments of SEQ ID NO:2, thus addressing the Office's concerns.

CONCLUSION

In view of the foregoing amendment and remarks, Applicants respectfully aver that the Examiner can properly withdraw the rejection of the pending claims under 35 U.S.C. §112, first and second paragraphs. Applicants respectfully submit that all claims pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

After the elected product claims have been found to be allowable, all withdrawn process (methods) claims which depend from or otherwise include all of the limitations of the allowed product claims should be rejoined.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. **564462001613**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

As noted above, Applicants have requested a telephone conference with the undersigned representative to expedite prosecution of this application. After the Examiner has reviewed the instant response and amendment, please telephone the undersigned at 858 720-5133.

Dated: October 10, 2006

Respectfully submitted,

By 

Gregory P. Einhorn

Registration No.: 38,440

MORRISON & FOERSTER LLP

direct dial 858 720 5133

general office 858 720 5100

fax direct 858 523 5933

fax office 858 720 5125

email geinhorn@mofo.com